



[3510-16-P]

## **DEPARTMENT OF COMMERCE**

### **United States Patent and Trademark Office**

**[Docket No.: PTO-P-2018-0032]**

### **Patent Cooperation Treaty Collaborative Search and Examination Pilot Project between the IP5 Offices**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Notice.

**SUMMARY:** The United States Patent and Trademark Office (USPTO), the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO) and the State Intellectual Property Office of the People's Republic of China (SIPO), referred to collectively as the IP5 Offices, will launch a pilot project on Collaborative Search and Examination (CS&E) under the Patent Cooperation Treaty (PCT). This will be the third such pilot. The USPTO, the EPO, and the KIPO conducted two previous pilots in 2010 and in 2011-2012. The third pilot is needed to further develop and test the concept amongst all the IP5 Offices. In particular, this IP5 pilot project aims

at assessing user interest for a CS&E product and the expected efficiency gains for the IP5 Offices.

**DATES:** *Pilot Effective date:* July 1, 2018.

*Duration:* Requests to participate in the PCT CS&E pilot project may be filed with international applications filed through the receiving Office of one of the IP5 Offices or the International Bureau of the World Intellectual Property Organization (WIPO) until June 30, 2020. During each year, the USPTO, in its capacity as the main International Searching Authority, will accept a total of 50 international applications into the pilot.

**FOR FURTHER INFORMATION CONTACT:** Inquiries regarding the handling of any specific application participating in the pilot may be directed to Daniel Hunter, Director of International Work Sharing, Planning, and Implementation, Office of International Patent Cooperation, by telephone at (571) 272-8050 or by email to [daniel.hunter@uspto.gov](mailto:daniel.hunter@uspto.gov). Inquiries concerning this notice may be directed to Michael Neas, Deputy Director, International Patent Legal Administration, by phone (571) 272-3289 or by email to [michael.neas@uspto.gov](mailto:michael.neas@uspto.gov).

## **SUPPLEMENTARY INFORMATION:**

### **I. Concept**

The concept of CS&E under the PCT refers to the collaboration of examiners from different International Searching Authorities in different regions and with different working languages on one international application for the establishment of an international search report and written opinion under PCT Chapter I, which, although remaining the opinion of the chosen International Search Authority, is based on contributions from all participating IP5 Offices.

Under the pilot project, the examiner of the IP5 Office from the chosen International Searching Authority under PCT Rule 35 for a given international application (“the main examiner”) works on the application by conducting the search and examination and by establishing a provisional international search report and written opinion. These provisional work products are transmitted to examiners from the other participating IP5 Offices in their capacity as an International Searching Authority (“the peer examiners”). Each peer examiner provides the main examiner with his contribution, in light of the provisional international search report and written opinion. The final international search report and written opinion are subsequently established by the main examiner after having taken into consideration the contributions of the peer examiners. Further details regarding the implementation of the CS&E concept within the framework of this pilot project are provided below.

## **II. Framework**

Under the pilot project, with a view to assessing the users' interest for a CS&E product, international applications processed under the collaborative scheme will be selected by applicants ("applicant-driven approach"), whereas, under the two previous pilot projects, the applications were selected by the participating IP5 Offices.

Applicants wishing to participate in the pilot project must submit a request for participation in the pilot on a standard participation form and file it together with the international application at the receiving Office of one of the IP5 Offices or the International Bureau. The participation form is available in all official languages of the IP5 Offices on WIPO's website at <http://www.wipo.int/pct/en/filing/cse.html>.

For international applications filed in English, requests for participation in the pilot may be filed beginning July 1, 2018. Each applicant will be able to select only a limited number of international applications for inclusion in the program.

Initially, only international applications filed in English will be accepted into the pilot. Eventually, international authorities that work in languages other than English will accept international applications filed in those languages into the pilot. Each main International Searching Authority that will accept international applications filed in a language other than English will inform the applicants accordingly by a communication published on its website. Such communication will specify the additional languages that will be accepted by a main International Searching Authority for the purposes of this pilot and the date as

of which requests for participation in the pilot may be filed in such languages. The USPTO in its capacity as an International Searching Authority only accepts applications in English.

The receiving Office will transmit the participation form to the International Bureau and the main International Searching Authority as part of the record copy and search copy, respectively. Upon receipt of the search copy, the main International Searching Authority will determine if the request for participation in the pilot may be accepted based on whether the applicable requirements detailed below in part III are met. The International Searching Authority will notify the applicant and the International Bureau of the acceptance or refusal of the request for participation in the pilot using Form PCT/ISA/224 (Communication in Cases for Which No Other Form Is Applicable).

The main International Searching Authority will perform the search and examination as it would for any other international application not processed under this pilot. It will establish a provisional international search report (Form PCT/ISA/210) (or, where appropriate, declaration of non-establishment of international search report (Form PCT/ISA/203)) and written opinion (Form PCT/ISA/237), and, where applicable, a record of the search strategy. The form and content of the record of the search strategy will generally be according to the current practice of each International Searching Authority.

The main International Searching Authority will transmit the above mentioned provisional work products to the peer International Searching Authorities, where a peer examiner will prepare a contribution to the final work product, taking into consideration the provisional work products prepared by the main International Searching Authority and performing additional searching to the extent deemed necessary.

With respect to the handling of cases lacking unity of invention by the peer International Searching Authorities, a principle of the first invention will be followed. This means that each main International Searching Authority proceeds with the non-unity procedure according to its own standard practice, while the provisional work products submitted to the peer International Searching Authorities are based only on the invention first mentioned in the claims as determined by the main International Searching Authority. Peer examiners will focus their searches on what they determine to be the first invention, regardless of whether the provisional work products are directed to one or more inventions.

Each peer International Searching Authority will transmit its contribution to the main International Searching Authority using a standard peer contribution form. Depending on its practice, each peer International Searching Authority will either record its contribution directly on the peer contribution form or use the peer contribution form as a cover sheet for the standard forms PCT/ISA/210 and PCT/ISA/237. Peer contribution forms and peer contributions attached to such forms, if any, will be made available as separate documents in WIPO's PATENTSCOPE.

The main International Searching Authority will consider the contributions received from the peer International Searching Authorities and prepare the final international search report (Form PCT/ISA/210) (or, where appropriate, declaration of non-establishment of international search report (Form PCT/ISA/203)) and written opinion (Form PCT/ISA/237) in light of these contributions. The main International Searching Authority will strive to establish these final work products within the time limit under PCT Rule 42.1; however, compliance with this time limit may not be guaranteed due to the collaborative nature of the pilot project, which inherently results in additional administrative burdens. The final work products will be transmitted to the applicant and the International Bureau.

Final CS&E work products will be identified, either by a direct indication in box V of Form PCT/ISA/237 or at the top of a supplemental sheet referenced in said box, as the result of the collaboration under the pilot, which does not necessarily reflect the opinions of all IP5 Offices. Only the final CS&E work product may serve as a basis for requesting participation in a Patent Prosecution Highway (PPH) pilot program.

All exchanges of documents and information among the IP5 Offices will be carried out via an ePCT-based platform allowing a secure and confidential data transmission. This ePCT-based platform is provided and maintained by the International Bureau.

In this pilot project, the international search fee charged by each IP5 Office remains unchanged. Therefore, applicants participating in this pilot will pay only the standard fee for a PCT Chapter I search at the chosen International Searching Authority. However, if following this pilot the CS&E product is implemented as a regular product under the PCT, applicants will have to pay a specific fee for such product (the CS&E fee). The maximum prospective amount of the CS&E fee is the aggregated amount of the search fees of the participating International Searching Authorities plus an administrative fee to cover the collaboration costs.

Towards the end of the pilot project, participating applicants will be asked to complete a questionnaire about their interest for a regular CS&E product under the PCT. Responses to the questionnaire will be taken into account by the IP5 Offices in the assessment of the pilot project.

### **III. Requirements and limitations for participation**

Applicants who would like to participate in the pilot project must be aware of both the following requirements to be met by applicants and the following limitations set by the IP5 Offices.

#### **A. Requirements to be met by applicants**

The following requirements must be met by applicants wishing to participate in the pilot project:



- (a) The request for participation in the pilot must be submitted on the standard participation form and filed together with the international application.
- (b) The participation form and the international application must be filed at the receiving Office of one of the IP5 Offices or at the International Bureau as receiving Office, and the applicant must select one of the IP5 Offices as the main International Searching Authority under PCT Rule 35. For example, U.S. applicants filing with the USPTO or the International Bureau as receiving Office may select the USPTO, the EPO, the KIPO, or the JPO as International Searching Authority, subject to certain limitations as described in the PCT Applicant's Guide, Annex C/US.
- (c) Where the participation form and the international application are filed with the USPTO, they must be filed in electronic form via the USPTO's EFS-Web system. The participation form must be loaded into EFS-Web as a separate document using document description "Request to Participate in PCT CS&E Pilot." This is true even where the participation form is prepared using WIPO's ePCT system since EFS-Web only extracts the PCT Request form and Fee Calculation sheet from ePCT or PCT Safe zip files.
- (d) The participation form and the international application must be filed in English when they are filed with the USPTO. As noted above, the other IP5 Offices will initially only accept applications filed in English and will announce when they are prepared to accept applications in languages other than English.

## **B. Limitations set by the IP5 Offices**

The following limitations related to organizational aspects of the pilot must be complied with for the main International Searching Authority to accept a request for participation in the pilot:

- (a) The applicant must not have had ten international applications accepted in the pilot by the same main International Searching Authority.
- (b) The main International Searching Authority must not have accepted 100 international applications into the pilot. The USPTO, in its capacity as the main International Searching Authority, will accept 50 applications during the first year of the pilot, that is from July 1, 2018, to June 30, 2019, and 50 applications during the second year of the pilot, that is from July 1, 2019, to June 30, 2020.
- (c) The main International Searching Authority must not determine that there is a defect in the application (e.g., the application does not contain a sequence listing portion of the description and/or a copy of a sequence listing in computer readable form as provided for in the Administrative Instructions under the PCT) impeding the processing of the application according to the timeline for the collaborative process.

## **IV. Duration**

The pilot project is divided into two phases, a preparatory phase and an operational phase. The preparatory phase started on June 2, 2016, and was dedicated to the administrative and practical preparations required for a smooth functioning of the pilot. The operational phase will start on July 1, 2018, and will be dedicated to the processing of applications under the collaborative scheme, the monitoring of applications for

evaluation purposes, and the assessment of the outcome of the pilot. The operational phase will last for a period of three years ending on July 1, 2021, and will include an evaluation of the impact of the pilot on examination during the subsequent national/regional stages. Requests for participation in the pilot will be accepted only during the first two years of the operational phase, i.e., from July 1, 2018, to June 30, 2020.

Dated: June 21, 2018.

Andrei Iancu  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
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